

REMARKS

Claims 1-14 are pending in this application. Claims 1, 3 and 14 are independent. In light of the amendments and remarks included herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claim 14 under 35 U.S.C. §102(b) as being anticipated by *Murrah et al.* (USP 5,804,807) and rejected claims 1-13 under 35 U.S.C. §103(a) as being unpatentable over *Murrah et al.* in view of *Roach et al.* (USP 6,310,997) and further in view of *Garber et al.* (USP 6,232,870). The Examiner further objected to claim 3 based on minor informalities. Applicant respectfully traverses these rejections.

Claim Rejections – 35 U.S.C. §102

The Examiner rejected claim 14 asserting *Murrah et al.* discloses all of the elements as recited in the claim. Applicants respectfully disagree with the Examiner's characterization of this reference.

At the outset, in support of the Examiner's rejection, the Examiner, again, fails to identify what portions of *Murrah et al.* he is relying upon to support each claim element. Should the Examiner maintain his rejection of the claims, Applicants respectfully request the Examiner provide the required information to support a *prima facie* rejection in a new, non-final Official Action so that Applicants may have a proper opportunity to respond to the rejection.

The disclosure of *Murrah et al.* is directed to a scan-ahead system where a roving attendant, presumably an employee of the shopping establishment, uses the portable scanning terminal to create an itemized list of all items in the customer's shopping cart just prior to checkout (col. 4, lines 19-23). The roving attendant further places the scanned items into a purchase bag and provided to the customer. The roving attendant completes scanning of all the customer's merchandise, tallies the total on the portable data collecting terminal and submits the contents of the customer's record to the central processor over a wireless communication network (col. 4, lines 40-47).

In contrast, the present invention of claim 14 provides for a tag reader for reading via radio waves commodity information written onto a wireless tag located on a sample commodity remote from a checkout area; and a wireless communication device for transmitting commodity

information to an information processing apparatus via radio waves at the same time that the commodity information is stored in the storage.

There is no disclosure in *Murrah et al.* that is directed to either of these claim elements. As *Murrah et al.* fails to teach or suggest all of the claim elements, Applicants respectfully submit that *Murrah et al.* fails to anticipate claim 14. It is respectfully requested that the outstanding rejection be withdrawn.

Claim Rejections – *Murrah et al./Roach et al./Garber et al.*

In support of his rejection of claim 1, the Examiner asserts that *Murrah et al.* discloses all of the elements of the claim, except for two elements. The Examiner relies on the teachings of *Roach et al.* to teach the commodity being displayed in a display area and having the customer pick up the item after purchases have been made. The Examiner further relies on the teachings of *Garber et al.* to teach RFID tags being modified and rewritable. The Examiner concludes that one skilled in the art would have been motivated to modify the teachings of *Murrah et al.* with the teachings of *Roach et al.* and *Garber et al.* in order to avoid purchasing new tags when replacing old commodities with new commodities or for a price change. The Examiner further asserts that it would be obvious to modify the teaching of *Murrah et al.* to lend to the customers the portable terminal. Applicants respectfully disagree with the Examiner's characterizations of the references.

In order to sustain a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

At the outset, the Examiner appears to admit that *Murrah et al.* fails to teach or suggest lending out a portable terminal capable of reading the tag. However, the Examiner fails to provide a

properly combinable reference curing the deficiencies of the teachings of *Murrah et al.* As such, the Examiner has failed to establish *prima facie* obviousness by failing to provide references that teach or suggest all of the claim elements.

Further, there is no teaching or suggestion in *Murrah et al.* that suggests the customer using the portable terminal. *Murrah et al.* merely discloses roving attendants using the portable terminal to facilitate the checkout process. The “data collection system” recited in col. 3, lines 4-9 appears to refer to the back end system that communicates with the portable terminals operated by the roving attendants. At col. 5, lines 20-27, *Murrah et al.* suggests that security is considered in order to prevent theft. There is no suggestion in *Murrah et al.* that would suggest the portable terminals being used by the customer, and as *Murrah et al.* clearly suggests the roving attendants using the portable terminals for security reasons, *Murrah et al.* appears to teach away from such a modification.

As the Examiner has failed to provide references that teach or suggest all of the claim elements, has failed to provide proper motivation for making the purported combinations, and has failed to consider clear teachings in *Murrah et al.* that teach away from the purported modification, the Examiner has failed to establish *prima facie* obviousness in support of his rejection of claim 1. As such, it is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claim 2 is allowable for the reasons set forth above with regard to claim 1 at least based upon its dependency on claim 1. It is further respectfully submitted that claim 3 includes elements similar to those discussed above with regard to claim 1 and thus claim 3, together with claims dependent thereon are allowable for the reasons set forth above with regard to claim 1.

Claim Objections

The Examiner objected to claim 3 based on a typographical error. By this amendment, Applicants have amended the claim to correct the typographical error. As such, it is respectfully requested that the outstanding objection be withdrawn.

Conclusion

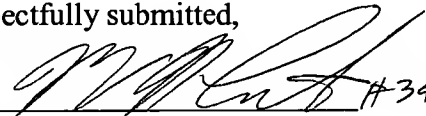
In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinnet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: October 2, 2006

Respectfully submitted,

By  #39,491
for Charles Gorenstein
Registration No.: 29,271
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant